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EXAMINER

LANDSMAN, ROBERT S

ART UNIT	PAPER NUMBER
1647	

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



## DETAILED ACTION

### *1. Formal Matters*

- A. The Amendment filed 11/19/07 has been entered into the record.
- B. Claims 1, 3 and 5-10 are pending. For the reasons below, claim 1 remains the sole examined claim.

### *2. Election by Original Presentation*

A. Claims 1, 3 and 5-9 are pending in the application. Claim 10 has been added. Newly submitted claim 10 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: in response to the Restriction Requirement dated 2/26/07, Applicants elected Group I, claims 1, 3 and 5, which are drawn to a probe. Claims 3 and 5 were withdrawn for the reasons already of record on page 2 of the Office Action mailed 5/15/07. Dopaminergic cells were restricted into Group II. The inventions are distinct, each from each other because of the following reasons:

The elected probe and the dopaminergic cell are independent and distinct for the reasons already of record on page 2 of the Restriction mailed 2/26/07.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 10 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. This original restriction was made **FINAL** in the Office Action dated 5/15/07.

### *3. Specification*

- A. The specification remains objected to since page 33 still does not recite a sequence identifier, nor have Applicants addressed this issue.

### *4. Claim Objections*

- A. The objection to the claims has been withdrawn in view of Applicants' removal of any recitation of SEQ ID NO:2 and 4.

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**5. Claim Rejections - 35 USC § 112, first paragraph – scope of enablement**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

A. Claim 1 remains rejected and new claim 10 is also rejected under 35 USC 112, first paragraph, for the reasons already of record on page 4 of the Office Action mailed 5/15/07. Applicants argue that, in contrast to the position of the Examiner, there is not undue experimentation to practice the invention as claimed and that it is known in the art how to make and use probes.

While it is true that the artisan can make a probe based on a given sequence, applicants have not demonstrated how to use that probe to identify a cell expressing a specific receptor without undue experimentation. The claims do not limit the size of the probe. Therefore, the claimed probes can, in theory, be as few as one base (i.e. the claims recite, for example, "a nucleotide sequence"). For this reason, it would be undue experimentation for the artisan to use any possible nucleotide sequence of the claimed polynucleotide to be able to identify a cell comprising the specifically claimed receptor. It would be expected that with a small enough probe, any DNA-containing cell would potentially express the claimed dopaminergic receptor. Therefore, the potential probes do not limit the amount of experimentation necessary. Claims drawn to a probe of at least 15 bases of SEQ ID NO:1 or 3 would be considered by the Examiner, as would claims drawn to polynucleotides which hybridize to the full length of SEQ ID NO:1. However, as written, this is not the case. Any argument by Applicants that fewer bases would successfully identify the claimed dopaminergic cells will be considered. However, the Examiner is still of the position that the claims have only adequately disclosed 2 examples (SEQ ID NO:1 and 3).

**6. Claim Rejections - 35 USC § 112, first paragraph – written description**

A. Claim 1 remains rejected and new claim 10 is also rejected under 35 USC 112, first paragraph, for the reasons already of record on page 5 of the Office Action mailed 5/15/07. Applicants' arguments are essentially the same as for enablement. These arguments are maintained for the reasons stated in the above enablement rejection. Applicants further state that they do not need to disclose every species of the claimed genus. This argument has also been considered, and is also not deemed persuasive. Applicants still need to disclose a representative number of species in the claimed genus.

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**7. Claim Rejections - 35 USC § 112, second paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A. The rejection of claim 1 under 35 USC 112, second paragraph, has been withdrawn in view of Applicants' amendment to add hybridization conditions.

**8. Claim Rejections - 35 USC § 102**

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

A. Claim 1 remains objected to under 35 USC 102(e) for the reasons already of record on page 6 of the Office Action mailed 5/15/07. Applicants stated that they reserve the right to make the required showing; however, no showing has been made at this time.

B. Claim 1 remains rejected over Tomita et al. for the reasons already of record on page 7 of the Office Action mailed 5/15/07. Applicants have not addressed this issue.

**9. Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

A. Claim 1 remains objected to for the reasons already of record on page 7 of the Office Action mailed 5/15/07. Applicants have not provided any Terminal Disclaimer at this time.

### ***10. Conclusion***

A. No claim is allowable.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Advisory information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (571) 272-0888. The examiner can normally be reached on M-F 10 AM – 7 PM (eastern).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Manjunath Rao at 571-272-0939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Robert Landsman/  
Primary Examiner, Art Unit 1647